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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,366	03/27/2000	Christopher J. Edge	53492USA1A	3630

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EXAMINER

CHUNG, DANIEL J

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,366

Applicant(s)

EDGE ET AL.

Examiner

Daniel J Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 25-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

Receipt is acknowledged of Applicant's Information Disclosure Statement of 7-17-2000, which has been placed in the application file and considered by the Examiner.

Drawings

The drawings are not objected to by the Examiner.

Specification

Please review the application and correct all informalities.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-31 and 34-46 are rejected under 35 U.S.C. 102(e) as being anticipated by McGregor et al (5,963,201).

Regarding claim 25, McGregor et al discloses that the claimed feature of a system comprising:

A source device profile interpreter[500-502-503-504] that interprets a source device profile to convert coordinates in a source device color space to a device independent color space;

A destination device profile interpreter[501-505-506-507] that interprets a destination device profile to convert coordinates in a destination device color space to the device independent color space

A color transformer[508-510-511-512-513;1515] that generates a color map defining a relationship between the source and destination device color spaces based on the converted coordinates and user preferences[22101] specified by a user independently of the source and destination device profiles. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

Regarding claim 26, McGregor et al discloses that the user preferences include illuminant functions. (See col 33 line 38-60)

Regarding claim 27, McGregor et al discloses that the user preferences include observer functions. (See Abstract, col 1 line 32-50, col 2 line 26-33, col 25 line 16-33, col 33 line 38-60)

Regarding claim 28, McGregor et al discloses that the color transformer adjusts the source and destination device profile interpreters based on the user preferences. (See Abstract, col 1 line 32-50, col 2 line 26-33, col 25 line 16-33, col 33 line 38-60)

Regarding claim 29, McGregor et al discloses that the source and destination profile interpreters are configured as removable plug-in modules for use by the color transformer. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

Regarding claim 30, McGregor et al discloses that the source and destination device profile interpreters are configured based on white and black point parameters to account for color variations between media and colorants used by different color display device. (See Fig 17-21, col 19 line 44-col 20 line 4, col 20 line 55-col 21 line 12)

Regarding claim 31, McGregor et al discloses that the source and destination device profile interpreters are configured based on pleasing color corrections. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

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Regarding claim 34, McGregor et al discloses that the source device profile contains raw spectral data that characterizes a source device, and the destination device profile contains raw spectral data that characterizes a destination device. (See col 33 line 38-60)

Regarding claim 35, McGregor et al discloses that each of the source and destination device profiles defines a forward transformation from one of the source and destination color spaces to the device independent color space. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

Regarding claim 36, McGregor et al discloses that the color map includes a look-up table. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

Regarding claim 37, McGregor et al discloses that the color map includes a mathematical expression. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

Regarding claims 38-46, claims 38-46 are similar in scope to the claims 25-27, and thus the rejections to claims 25-27 hereinabove are also applicable to claims 38-46.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGreggor et al in view of Berlin et al (6,011,540).

Regarding claim 32, McGreggor et al discloses that the color transformer generates the color map in part by reducing color error between the converted coordinates from the source and destination device profile interpreters. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

McGreggor et al does not explicitly disclose that "reducing color error." However, such limitation of Applicant's invention is shown in the teaching of Berlin et al. (See Abstract, Fig 3, Fig 4, Fig 5, col 2 line 60-col 4 line 34) The motivation would have been to generate proper color data by manipulating colors independent of the source and destination color space. Therefore, it would have been obvious to one skilled in the art to incorporate the teaching of Berlin et al into the teaching of McGreggor et al.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGreggor et al in view of Berlin et al, and further in view of Schwartz et al (5,999,703).

Regarding claim 33, McGreggor et al discloses that the source and destination device profile interpreters use forward transformation profiles to produce the converted coordinates, and the color transformer adjusts coordinates in the destination device color space to reduce the color error, the color map being based in part on the adjusted coordinates in the destination device color space. (See Abstract, Fig 1, Fig 2, Fig 14, Fig 15, Fig 16, Fig 22, col 1 line 53-col 3 line 39)

McGreggor et al does not specifically discloses that "forward transformation profiles." However, such feature of claimed invention is disclosed in the teaching of Schwartz et al. (See Abstract, Fig 1, col 6 line 1-21, col 7 line 45+) The motivation would have been to produce color reproduction with easy manner. Therefore, it would have been obvious to one skilled in the art to incorporate the teaching of Schwartz et al into the teaching of McGreggor et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25,32-33,38 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,10,13,18,37,41,45-47 of U.S. Patent No. 6,088,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because claimed feature of invention is just broadly claimed by Applicant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Chung whose telephone number is (703) 306-3419. He can normally be reached Monday-Thursday and alternate Fridays from 7:30am- 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael, Razavi, can be reached at (703) 305-4713.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

djc
April 6, 2002

A handwritten signature in black ink, appearing to read 'Matthew Luu', with a stylized flourish at the end.

**MATTHEW LUU
PRIMARY EXAMINER**